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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,580	08/28/2003	Se-Youn Lim	5000-1-448	8236
33942	7590	04/30/2008		
CHA & REITER, LLC 210 ROUTE 4 EAST STE 103 PARAMUS, NJ 07652				
EXAMINER				
FOUD, HICHAM B				
ART UNIT		PAPER NUMBER		
2619				
MAIL DATE		DELIVERY MODE		
04/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,580

Applicant(s)

LIM ET AL.

Examiner

HICHAM B. FOUAD

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/07/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 4 and 5 is/are allowed.
- 6) ☐ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/07/2008 has been entered.

Response to Amendment

2. The amendment filed on 03-07-2008 has been entered and considered.
- Claims 1-5 are pending in this application.
- Claims 1 and 3 remain rejected as discussed below.
- Claims 2, 4 and 5 are allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, the recitation "performing the loopback process using the loop-back control OAM PDU without sending OAM PDU information messages" is vague and

indefinite because how would the loop-back process is going to be performed without sending the information messages that define the steps of the loop-back process.

Claim 3 is rejected because of its dependency on the rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over IEEE 802.3ah Ethernet in the First Mile Task Force), hereinafter referred to as APA in view of Han (US 6,873,599).

As best understood:

For claim 1, APA discloses a method of controlling a loop-back process between a local device and a remote device in an Ethernet passive optical network (see page 5 under TEST, wherein the test between the local and remote devices), the method comprising the steps of: (a) providing a predetermined field in a loop-back control OAM PDU, the predetermined field having distinguishing messages for an initiation of the loop-back process (see page 4 under OAM Frame, wherein byte 01 is a request to initiate the loop-back) and a termination of the loop-back process (see page 4 under OAM Frame, wherein byte 02 is a response to terminate the loop-back); and (b) the local device and the remote device performing the loop-back process including an

initiation using the loop-back control OAM PDU (see page 5 under TEST, wherein the request and the response are the loop-back process between the local and remote devices).

APA discloses all the subject matter with the exception of wherein the loop-back process initiation step includes the step of: transmitting, by the local device, a loop-back control OAM PDU requesting an initiation of the loop-back process to the remote device and the loop-back process termination step includes the step of transmitting by the local device, a loop-back control OAM PDU requesting a termination of the loop-back process to the remote device. However, Han discloses a method wherein the loop-back process initiation step includes the step of: transmitting by the local device, a loop-back control OAM PDU requesting an initiation of the loop-back process to the remote device (see Figure 3, wherein element 102 is the local device, element 118 is the remote device, steps (300 and 302) is the initiation step) and the loop-back process termination step includes the step of transmitting by the local device, a loop-back control OAM PDU requesting a termination of the loop-back process to the remote device (see Figure 3, wherein element 102 is the local device, element 118 is the remote device, steps (312 and 314) is the termination step). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the method of Han into the system of APA for the purpose for setting up a connection before the start of loopback operation and tearing down the connection at the end of the loopback operation.

For claim 3, Han further discloses a loop-back method, wherein the loop-back process initiation step further includes: transmitting, by the remote device, a loop-back

control OAM PDU acknowledging the initiation of the loop-back process to the local device (see Figure 3, wherein element 102 is the local device, element 118 is the remote device, steps (306 and 308) is the acknowledgement to the initiation step (steps 300 and 302)).

Allowable Subject Matter

5. Claims 2, 4 and 5 are allowed.

Response to Argument

6. Applicant's arguments filed 03/07/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the added limitation "without sending OAM PDU information messages" is further limiting the claim because it refers back to the disclosure (page 6 line 17 -page 7 line 4), the examiner disagrees with the applicant because the added limitation in a combination with the other recited limitations create a confusion (see the 112 rejection above) and also, the claims are given their broadest reasonable interpretation (The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)) because although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

In response to applicant's arguments in pages 9-10 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is clear from the APA (primary reference) that there is a local device and a remote device in communication, and therefore the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

7. Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art

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disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hicham B. Foud whose telephone number is 571-270-1463. The examiner can normally be reached on Monday - Thursday 10-3 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hicham B Foud/
Examiner, Art Unit 2619
04/24/2008

/CHAU T. NGUYEN/
Supervisory Patent Examiner, Art Unit 2619